

PATENT  
2121-128PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Georges BAHR GROUP: 1806  
SERIAL NO.: 08/809,650 EXAMINER: Parkin, J.  
FILED: June 13, 1997 ART UNIT: 1648

FOR: COMPOSITIONS OF MURAMYL PEPTIDES INHIBITING THE  
REPLICATION OF HIV

**RESPONSE TO RESTRICTION REQUIREMENT**

Honorable Commissioner of  
Patents and Trademarks  
Washington D.C. 20231

Sir:

The Examiner has required a restriction, allegedly under 35 U.S.C. § 121, in which the applicant has been required to elect a **single disclosed chemical compound** from Group I, because the Examiner alleges that each "methodology claim employing a different chemical compound would constitute an independent and distinct invention." Applicant respectfully traverses this requirement and urge that the Examiner's position is not proper under 35 U.S.C. § 121.

First of all, the Examiner is reminded that this application is the National Stage filing of a PCT International application. As such, unity of invention standards must be applied to any restriction requirements in this case. It does not appear from the Office Action that the Examiner considered unity of invention standards, and under unity of invention standards all of the claims should be prosecuted in one application. This is

evidenced by the fact that no unity of invention objection was raised during the International Examination procedure.

The Examiner's requirement is also improper under 35 U.S.C. §121. Restriction practice under §121 provides authority for an Examiner to restrict between claims, but does not provide any authority for attempting to make a restriction from within a claim. As explained by the United States Court of Customs and Patent Appeals:

"It is apparent that §121 provides the Commissioner with the authority to promulgate rules designed to restrict an application to one of several claimed inventions when those inventions are found to be 'independent and distinct.' It does not, however, provide a basis for an Examiner acting under the authority of the Commissioner to reject a particular claim on the same basis."

*In re Weber*, 198 USPQ 328, 331 (CCPA 1978).

Thus, an Examiner can properly make a restriction between different groups of claims but cannot properly restrict an application by dividing one particular claim and making a restriction from within that claim. In attempting to take such an action, an Examiner is improperly refusing to examine an applicant's broad generic claim, and 35 USC §121 cannot be utilized as a tool to avoid examination of even a broad generic claim. This is true even if the broad generic claim covers a plurality of independent patentable species. As stated by Judge Rich:

"So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad generic claim -- no matter how broad, which means no matter how many independently patentable inventions may fall within it."

*id.* @ 331-332.

Thus, in the present application it is improper for the Examiner to refuse to examine applicant's broad generic claim 1 by asserting a "restriction requirement" from

within applicant's broad generic claim 14. 35 USC §121 simply does not provide authority for the Examiner to make such a restriction requirement.

The proper procedure for the Examiner in this situation is to issue a requirement for an "election of species." As set forth in MPEP §803, the Examiner can properly require the applicant to elect a single disclosed species from which to begin examination, but then the substantive examination must be broadened to other species encompassed by the generic claim after the elected species is found allowable.

So in the present situation, applicant submits that the proper procedure is for an election of species, and applicant elects for this purpose, the compound referred to as "murabutide" referred to at page 5, line 4 of the specification.

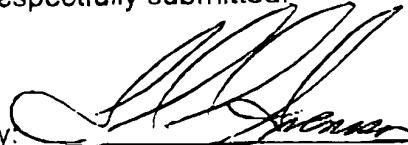
If, however, the Examiner persists in the purported restriction requirement, in order to fully comply with the requirement, applicant elects the same compound referred to in the specification as "murabutide."

The applicant hereby petitions for an extension of time of one month for filing a response to the outstanding office action. Please charge the required fee of \$110.00 to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Dated: 18 Sept 1998

Respectfully submitted,

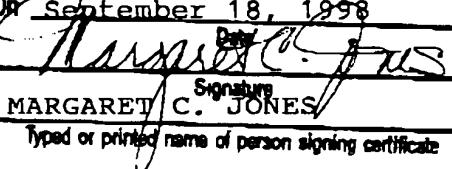
By: 

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LRS/mj

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# RESTRICTION/ELECTION FACSIMILE TRANSMISSION

DATE: September 18, 1998

FROM/ATTORNEY: Leonard R. Svensson

FIRM: Birch, Stewart, Kolasch & Birch, LLP

PAGES, INCLUDING COVERSHEET: -5-

PHONE NUMBER: (714) 708-8555

TO EXAMINER: Parkin, J.

ART UNIT: 1648

SERIAL NUMBER: 08/809,650

FAX/TELECOPIER NUMBER: (703) 305-3704

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COMMENTS: This is a retransmission of the response with a  
petition for a one month extension of time.

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